

REMARKS/ARGUMENTS

Prior to entry of this Amendment, claims 1-5 were pending in this application. No claims have been amended, no claims have been canceled and claims 6-13 have been added herein. Therefore, claims 1-13 are now pending. Applicant respectfully requests reconsideration of these claims for at least the reasons presented below.

35 U.S.C. § 101 Rejection, Non-statutory matter

The Office Action has rejected claims 1-5 under 35 U.S.C. § 101 as allegedly being directed to non-statutory matter. More specifically, the claims have been rejected for failing to recite a tangible and useful result and therefore failing to meet the statutory requirements. The Office Action cites the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter "Guidelines") and argues that claim 1, upon which claims 2-5 depend do not provide a practical application, i.e., that they do not provide a "useful, concrete, and tangible result." The applicants respectfully maintain that, for at least the reasons presented herein, the claims are in fact directed to statutory subject matter and that the rejection is improper.

As a threshold matter, the Examiner is respectfully directed to the recent decision of the Board of Patent Appeals and Interferences ("the Board") in Ex Parte Lundgren, Appeal No. 2003-2088, ___ U.S.P.Q.2d ___ (Bd.Pat.App.Int'f 2005). Therein, the Board reversed the Examiner, specifically holding that no separate technological arts test is required under 35 U.S.C. §101. Based upon the Ex Parte Lundgren decision, it is respectfully asserted that the alleged failure to offer a practical application in the technological arts is not a proper basis for rejecting the claims, and any claim rejections on this ground should be withdrawn.

Regarding purported failure of the claims to be limited to "practical applications", the Examiner is respectfully reminded:

... applicant is in the best position to explain why an invention is believed useful. Office personnel should therefore focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement. (Emphasis added; MPEP §2106.I.A.)

Here, the instant specification provides ample disclosure regarding practical application of the claimed subject matter. For example, at ¶[0027], the specification describes a practical application of the recited method, e.g., using the business logic represented by the resulting action sets and associated action statements in the implementation of new code in another computer language. The detailed description present in the instant specification regarding use of the claimed principles in conjunction with a concrete, "real world" application, certainly satisfies the requirement of MPEP §2106.I.A. set forth above. Accordingly, Applicants have demonstrated at least one practical application for the claims, and continued rejection of the claims under 35 U.S.C. 101 is improper.

35 U.S.C. § 102 Rejection, Carpenter

The Office Action has rejected claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,199,068 B1 to Richard Carpenter (hereinafter "Carpenter"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 1-13 submitted by the Applicants and Carpenter.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Carpenter fails to disclose each and every claimed element. For example, Carpenter fails to disclose, either expressly or inherently, examining statements in computer code to identify a plurality of conditional statements and a plurality of action statements, tagging the plurality of conditional statements and the plurality of

action statements, generating action sets based on the conditional statements, or identifying associated sets of action statements.

Carpenter "relates generally to an automated meter reading (AMR) system, and more particularly to an AMR server within the automated reading system which collects, loads and manages data from energy meters, and processes and stores meter data for routing to end users and business systems." (Col. 1, lines 14-19) To this end, Carpenter discloses "a computer system having a canonical mapper to translate an input file from an input domain to an output domain." That is, Carpenter discloses a mapper for translating a collection of meter data from an input format to an output format. Therefore, as an initial matter, Carpenter does not relate to extracting business logic from computer code having a plurality of statements.

In an attempt to demonstrate such teachings, the Office Action cites a portion of the paragraph that begins at Col. 10, line 64. This paragraph, in its entirety, states:

"The present invention improves upon traditional three-tiered systems to be flexible and to accommodate dynamic business requirements. This flexibility is provided by the AMR Server 15 as an extension made to the traditional three-tiered approach. This extension is to extract business logic into objects called Activity Plans. Activity Plans or work flows control the flow of work in a system. The Activity Plans are an independently driven set of flexible and cooperating services that do not require programming, as the business logic is not hard-coded into the system, but appears as tasks in Activity Plans. The Activity Plans can thus accommodate different business models. Further, the Activity Plans contain a well-defined interface, and encompass dynamic rules." (Col. 10, line 64 - col. 11, line 10)

That is, Carpenter discloses an AMR Server that is program to perform the translation of a collection of meter data from an input format to an output format via a set of work flows (Activity Plans) "that do not require programming," i.e., are "not hard-coded into the system." (Col. 11, lines 3-7) Thus, Carpenter does not relate to extracting business logic from computer code having a plurality of statements.

Furthermore, assuming for the sake of argument that the cited paragraph of Carpenter can be considered to demonstrate such a teaching, Carpenter does not disclose examining statements in computer code to identify a plurality of conditional statements and a plurality of action statements, tagging the plurality of conditional statements and the plurality of action statements, generating action sets based on the conditional statements, or identifying associated sets of action statements.

Claim 1, upon which claims 2-5 depend, claim 6, upon which claims 7-9 depend, and claim 10, upon which claims 11-13 depend, each recite in part "examining the plurality of statements to identify a plurality of conditional statements and a plurality of action statements; tagging the plurality of conditional statements and the plurality of action statements, wherein each conditional statement has an associated tag and each action statement has an associated tag; grouping the plurality of conditional statements and the plurality of action statements; generating a plurality of action sets based on the plurality of conditional statements, wherein each of the plurality of action sets includes an associated set of action statements; [and] for each action set, identifying the associated set of action statements from the grouped plurality of action statements." Carpenter does not disclose, expressly or inherently, examining statements in computer code to identify a plurality of conditional statements and a plurality of action statements, tagging the plurality of conditional statements and the plurality of action statements, generating action sets based on the conditional statements, or identifying associated sets of action statements. For at least these reasons, claims 1-13 should be allowed.

35 U.S.C. § 103 Rejection, Carpenter in view of Ohkubo

The Office Action has rejected claim 5 under 37 U.S.C. § 103(a) as being unpatentable over Carpenter in view of U.S. Patent No. 5,742,827 to Ohkubo et al. (hereinafter "Ohkubo"). Applicants respectfully request withdrawal of the rejection and allowance of the claim for at least the reason that claim 5 depends upon independent claim 1 which is thought to be allowable as discussed in detail above.

Appl. No. 10/699,566

PATENT

Amdt. dated: January 5, 2007

Reply to Office Action of October 6, 2006

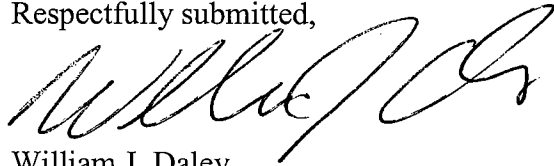
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Dated: January 5, 2007

Respectfully submitted,



William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000 (Denver office)
Fax: 303-571-4321 (Denver office)

WJD/sbm

60907848 v1